

REMARKS

Claims 52-59 are pending in the present application. Claims 52-54, 56-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ramous* (U.S. #5,896,533) in view of Allard et al. (U.S. #5,991,802). Claim 55 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Ramous* (U.S. #5,896,533) in view of Allard et al. (U.S. #5,991,802) and further in view of Sengoku et al. ("Hypertext Type Information Providing Information Retrieving Device"). Applicants respectfully traverse the rejections. Favorable reconsideration is respectfully requested.

Regarding claim 52, *Ramous* does not teach "an object embedding program, implemented on a computer in said communications network, comprising a link to said network-based information provided by said one of said network servers and a link from which said object embedding program can locate said script program" (emphasis added). This feature is similarly claimed in claim 59 as well. The Examiner has previously conceded that *Ramous* does not teach a script program (paragraph 1 of Office Action 12/4/03), thus it follows that *Ramous* can not teach an object embedding program having the configuration claimed in claim 52 and 59. Also, *Ramous* does not teach the object embedding program "being structured to apply said script program to said network-based information so as to cause said data to be extracted from said network-based information" as recited in claim 52 (and similarly in claim 59). For the same reason as above, *Ramous* does not teach this limitation. .

Applicant respectfully requests that greater clarity be given in the Office Action for reasons of rejection. In the Office Action of December 4, 2003 the Action claims that *Ramous* fails to teach a script program (page 1, paragraph 1, line 10), yet the Office Action of May 4, 2004 suddenly recites the Presentation Mechanism Object (304) as being a script program, without any explanation.

Nevertheless, regarding the feature of a "script program", *Ramous* states that:

Presentation Mechanism 304 acts as an OLE surrogate server 308 and OLE surrogate container 310 for a WWW document. When a user activates an embedded WWW document, OLE surrogate server 308 calls Data Access Mechanism 306 to create a local copy of the WWW document referenced by OLE surrogate server 308,

OLE surrogate server 308 then determines which server application should be activated based on the type of WWW document and activates the real OLE server 302

(col. 4, lines 17-25). *Ramous* further states that

Presentation Mechanism 304 acts as a conduit between the container application and the real OLE server 302 such that they communicate with one another as though the real OLE server 302's document is directly embedded in the real OLE container 300. Thus, although Presentation Mechanism 304 acts as both OLE server 302 and OLE container 300 via OLE surrogate server 308 and OLE surrogate container 310, to the real OLE container application 300, Presentation Mechanism object 304 appears as the real OLE server 302. Further, to OLE server 302, Presentation Mechanism object 304 appears as the real OLE container 300. Thus, Presentation Mechanism 304 intercedes in the normal operation of OLE such that it may replace the URL with local files that OLE server 302 may handle.

(col. 4, lines 26-39). Thus, the Presentation Mechanism 304 as disclosed in *Ramous* does not “extract data from network-based information provided by one of said network servers”, but instead replaces URLs with local files for the real OLE server to handle. In other words, the Presentation Mechanism does not “extract” anything, but instead passes embedded WWW documents with local copies made by the Data Access mechanism (see col. 5, lines 37-63). It is not understood how the “drag and drop” passage of col. 3, lines 50-55 relates at all to extracting data by a script program as recited in the present claims.

Next, the present invention also claims an object embedding program, comprising “a link to said network-based information provided by said one of said network servers and a link from which said object embedding program can locate said script program.” The object embedding program is further structured to “apply said script program to said network-based information so as to cause said data to be extracted from said network-based information, and to embed said data within a compound document implemented on a computer in said communications network.” These features are recited in claim 52 and similarly in claim 59.

In contrast, the Office Action cites a general passage about OLE applications (col. 3, lines 49-55, 60-67) to allege that the aforementioned features are disclosed. The passage in col.

6, lines 10-15 merely describes a document insertion dialog, where the Presentation Mechanism 304 may be registered to appear in a menu list as a “WWW Document”. Again, how this passage relates to the features discussed above is not at all clear. The Examiner has appeared to have conceded that *Ramous* does not disclose a link in which the object embedding program can locate the script program

The *Allard* reference teaches a method and system that uses shim scripts to manage, through a server, the invoking of the methods of object classes in response to receiving requests from clients (col. 3, line 60 to col. 4, line 23). The passages cited by the Examiner merely discloses a script that instantiates an object of the object order class of a customer purchase order, and invokes a method to add the object to a customer order (col. 4, lines 40-50). *Allard* is silent regarding configuration described above.

Again, there is no suggestion or motivation to combine *Ramous* with *Allard*. For what reason would one skilled in the art be motivated to include script program of *Allard* with the teaching of *Ramous*? The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). (MPEP 2142). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986).

Furthermore, The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (MPEP 2143.01). *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983) (MPEP 2141.02). No such suggestion to modify is found in *Ramous* and *Allard*. Furthermore, it is entirely unclear what was meant in the Office Action when it was

stated that it would have been obvious to combine the URL shim script of *Allard* with the teaching in *Ramous* to "permit a client to specify that a computer program is to be executed by using URL." First, the Presentation Mechanism of *Ramous* does not act as a script program for the reasons given above, and secondly, there is nothing in *Ramous* that would teach or suggest that the combination of *Allard* would achieve the stated result (see MPEP 2143.02). Motivation must be found to combine references and no motivation is found to combine *Allard* with a modified *Ramous* in order to find the present invention obvious.

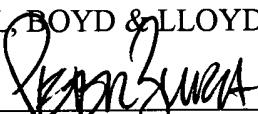
For at least these reasons, the Applicants submit that the §103 rejections are improper and should be withdrawn. Since claims 53-58 depend directly and indirectly from claim 52, it follows that these claims are allowable as well. Applicants earnestly request an early Notice of Allowance.

If any fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket number (0115274-00005) on the account statement..

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY



Peter Zura

Reg. No. 48,196

P.O. Box 1135

Chicago, Illinois 60690-1135

Phone: (312) 807-4292

Dated: August 4, 2004